

REMARKS

Upon entry of the present amendment, claims 1-2, 4-15 and 17-20 will remain pending in the above-identified application, with claims 1, 4-5 and 11-12 standing ready for further action on the merits and remaining claims 2, 6-10, 13-15 and 17-20 being withdrawn from consideration based on an earlier election of species requirement of the Examiner.

The amendment made herein to claim 1 does not incorporate new matter into the application as originally filed. In this respect, the amendment clarifies that the wing portions are "rear" wing portions" and that each of the rear wing portions includes a liquid-retentive wing portion absorbent core "that comprises embossed absorption paper." The amendments find support throughout the original application as filed, including original claims 1 and 4. Accordingly, entry of the present amendment is required at present.

Election of Species Requirement

The Examiner previously required an election of species in the matter of the instant application. Specifically, the Examiner required an election in the present application between: Species 1, illustrated in Figures 1-2; Species 2, illustrated in Figure 3; and Species 3, illustrated in Figures 4-6. In response to the Election of species requirement, Applicants elected Species 1, illustrated

in Figures 1-2 with traverse. Traversal is based on the fact that no undue burden would be placed on the Examiner to consider each of the pending claims at present as is clearly evidenced based on a review of each of Figures 1-6 and each of the currently pending claims 1-2, 4-15 and 17-20.

Claim Interpretation

The Examiner's comments as set forth at page 2 of the office action are noted. Also noted is the following excerpt from the Manual of Patent Examining Procedure (MPEP) at § 2111.1, which in part discusses using an applicant's specification to interpret claim language:

...It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970). See also Superguide Corp. v. DirectTV Enterprises, Inc., 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004) ("Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment."); E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) ("Interpretation of descriptive statements in a patent's written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or a description of a preferred embodiment. The problem is to interpret claims 'in view of the specification' without unnecessarily importing limitations from the specification into the claims."); Altiris Inc. v. Symantec Corp., 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003)....

Claim Rejections Under 35 USC § 102/103(a)

Claims 1, 4-5 and 11-12 have been rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over Van Tillburg (US 5,489,283). Reconsideration and withdraw of the rejection is respectfully requested based on the amendments made herein to the claims and the following considerations.

Request for Corrected PTO-892 form

First, while the Examiner correctly indicates the patent number for Van Tillburg in the Office Action (i.e., US 5,489,283), nonetheless, the Examiner's provided "Notice of References Cited" PTO-892 form is incorrect, since it refers to US 4,589,283 of Morrison, Jr. (which relates to a gauge for warning a SCUBA diver of an unsafe rate of ascent in the ocean or sea). As such, the Examiner is respectfully requested to issue a new PTO-892 form correctly citing the Van Tillburg reference (US 5,489,283).

Distinctions Over the Cited Art

A characteristic feature of the present invention resides in presence of "rear wing portions", which have a liquid retentive wing portion absorbent core that comprises "embossed absorption paper".

The rear wing portions cover the shorts of the wearer in the wider range, when the napkin is attached to the shorts, thereby preventing blood from leaking to the rear side. *Please see page 10, lines 8-10 of the instant specification.* In contrast, while Van Tillburg US '283 discloses wing portions, they are located at the longitudinally central position of the sanitary napkin, as clearly depicted in Figure 1 of Van Tillburg US '283.

The rear wing portions of the present invention are characterized by low diffusion or dispersibility of liquid, since the rear wing portions have a supplemental function to the body absorbent core. In the present invention, the absorptive area is used to correspond to the degree of liquid diffusion or dispersibility (i.e., a lower absorptive area means lower liquid diffusion). Thus, in the claimed sanitary napkins, the rear wing portion absorbent core has such a low liquid diffusion, i.e., an absorptive area of 80 cm² or less, in order to prevent body fluids from unduly diffusing over the rear wing portion and thereby prevent leakage. *See page 6, lines 19-27, particularly lines 25-27; and page 8, lines 5-21, particularly 16-21 of the instant specification.*

There is no disclosure or suggestion in Van Tillburg US '283 regarding any reduced liquid diffusion of rear wing portions, and further no motivation is provided by Van Tillburg US '283 that

would allow one of ordinary skill in the art to arrive at such a construction.

In addition, column 6, lines 18-20 of Van Tillburg US '283 explicitly teaches that its flap absorbent core 230 *"can be made from any of the materials that can be used to make the absorbent core 216 as described above."* This means that Van Tillburg's flap absorbent core 230 has the same absorption performance as its central absorbent core 216. In general, however, those skilled in the art realize that the central absorbent cores of sanitary products are designed to have a higher liquid diffusion performance in order to make efficient use of the whole absorbent core. Therefore, it follows that the flap absorbent core 230 of Van Tillburg US '283 would be considered by those skilled in the art to have a liquid diffusion performance, i.e., absorptive area, of higher than 80 cm², which is outside the claimed invention.

As a further distinction over Van Tillburg US '283, it is again noted that claim 1 has been amended to recite a liquid retentive wing portion absorbent core *"that comprises embossed absorption paper"*. Notably, embossing of the absorption paper is advantageous to reduce liquid diffusion so that a "solution disperses to an area of the wing portion absorbent core measuring no larger than 80 cm²."

Based on each of the above considerations, it is clear that the cited Van Tillburg US '283 reference does not teach or provide

for each of the limitations recited in pending claim 1. As a result it is incapable of anticipating the present invention as claimed. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Also, because the cited Van Tillburg US '283 reference provides no motivation to arrive at the instant invention as claimed, it cannot provide a proper basis for supporting a *prima fascia* obviousness rejection of the claims under 35 USC § 103(a).

As indicated in MPEP §§ 2143 and 2143.01:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a

motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)....

Accordingly, withdraw of all outstanding rejections is properly requested and required at present.

CONCLUSION


Based on the amendments and remarks presented herein the Examiner is respectfully requested to issue a notice of allowance in the matter of the instant application, clearly indicating the allowability of each of the pending claims under consideration (i.e., claims 1, 4-5 and 11-12). The examiner is also respectfully requested to reconsider the earlier election requirement and to again consider the patentability of currently withdrawn claims 2, 6-10, 13-15 and 17-20.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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